

REMARKS

The Examiner's comments together with the cited references have been carefully studied. Favorable reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

Claims 1-8 are pending in the application. Claims 1-8 have been rejected. Claims 1-2 herewith are amended. Claim 9 is added. Claims presently active are claims 1-9. Favorable reconsideration of the application in view of the following remarks is respectfully requested

Amendments

Claims 1 and 2 have been corrected to overcome the objections stated in the Office Action. Claim 1 has also been amended to place the details of a drag element in a "wherein" clause rather than a "whereby" clause. This change is supported, among others, on pg. 4 lines 21-28 of the application as filed.

New claim 9 has been added to claim the scope of protection to which Applicant believes he is entitled. Claim 9 does not include the feature of accommodation segments presented January 19, 2010. Specifically, claim 9 sets forth apparatus for depositing a sheet on a stack (supported on pg. 1 line 4 of the specification as filed, and in FIG. 1), including a stack bar adjacent to the stack (bar 12 in FIG. 1; pg. 4 lines 15-20). The apparatus also includes a stacking device (two are shown in FIG. 4 inboard of the two driving wheels 15; pg. 5 lines 30-32) rotatable about an axis of rotation (pg. 5 line 30) to grasp and deposit the sheet on the stack (pg. 4 lines 9-15). The stacking device includes a drag element (element 1 in FIG. 4; pg. 5 lines 13-14, 23-26, 32) arranged on a radial exterior side of the stacking device (element 1 in FIGS. 2 and 3; pg. 5 lines 23-24) and carried along during rotation thereof (pg. 5 lines 21-22, 24-25), so that the drag element pulls the uppermost deposited sheet on the stack toward the stack bar (pg. 5 lines 24-26; pg. 4 lines 21-22).

Rejections

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as being anticipated by Holtje (US 5,692,740). Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Holtje in view of Michler (US 2003/0021659). These rejections are traversed.

The Examiner's attention is respectfully drawn to the declaration of Dr. Detlef Schulze-Hagenest, submitted herewith. This declaration describes (section 8) that Holtje does not provide accommodation segments as set forth in claim 1. This clearly demonstrates that claim 1 is novel over Holtje. Moreover, the declaration describes the unexpected advantages of claim 1 over Holtje and Michler, taken singly or in combination, and that one of ordinary skill in the art would not have a reasonable expectation of success at combining the cited references to produce the invention set forth in claim 1. Claims 2-6, 7, and 8 depend from claim 1 and should be allowed with it.

With regards to independent rotation, Holtje parts 58a, 58b are not accommodation segments, as shown by the above-referenced declaration. Therefore, they do not meet the features of claim 1 (see section 8 of the declaration). With regards to the statement in the Office Action that independent rotation does not structurally define over the prior art, Applicant respectfully traverses this assertion. See "Response to Arguments," below.

Applicant therefore respectfully requests that the rejections of the claims under 35 U.S.C. 102(b) and 103(a) be withdrawn.

Even without considering the accommodation segments, independent claim 1 and new independent claim 9 are both novel over Holtje '740 and unobvious over Holtje in view of Michler '659 due to the presence therein of drag elements. Claims 1 and 9 both set forth drag elements that pull deposited sheets towards a stack bar (stack abutment, in claim 1). Nothing in Holtje or Michler teaches or provides any suggestion of drag elements. Throughout this discussion, "lateral positioning" refers to the position of a sheet on the stack with respect to the other sheets in the stack. It is desirable that all sheets in the stack have the same lateral position (pg. 1 line 34-pg. 2 line 2 of the present application).

Referring to Holtje FIGS. 2 and 3, outer ends 68a, 68b of finger units 56a, 56b are described in col. 7 lines 49–55. Referring to Holtje FIG. 1, finger outer end surfaces 28a, 28b of fingers 16a, 16b are described in col. 6 lines 24–35, 52–61. As described in col. 6 line 62–col. 7 line 15, the outer ends engage the top of the stack before the sheet is fully released from the sheet slot (col. 6 lines 62–67). Col. 6 line 67–col. 7 line 4 states that the outer end surface is between the existing top of the stack and the new sheet to be placed on the stack. Nothing in this description indicates that the outer end surfaces cited in the Office Action transport or urge sheets laterally at all, much less towards the stack bar as required in claims 1 and 9.

Holtje col. 7 lines 16–25, in fact, describe a structure completely different in principle of operation than the structure of claims 1 and 9. Holtje states that “the sheet, before it is released, is positively brought down into very close spacing ... with the top of the stack ... rather than ... releasing the sheet in mid-air above the stack”. In contrast, pg. 1 lines 27–29 of the present application set forth that “the leading edge of the sheet ... is ... released by said input means so that the released sheet drops onto the stack from a certain height.” Lines 30–31 describe that “heights on the order of approximately 15mm may occur.”

Referring to Holtje FIG. 1, Holtje states in col. 7 lines 26–31: “... it is highly desirable to coordinate the release of the incoming sheet to be stacked with the lowering thereon of a bail such as 30, preferably with a high friction robber or other bail top 32 to engage *with normal force* and help *hold* the sheet in its proper registration position” (emphasis added). That is, first, the sheet is positioned laterally and anchored in place by the bail, and then the finger is removed to deposit the sheet on the stack. In contrast, in claims 1 and 9, the sheet is released and falls onto the stack, and is subsequently brought into lateral position by the drag elements. Holtje col. 7 line 56–col. 8 line 11 describes the bails in more detail with reference to FIGS. 2 and 3. Specifically, col. 7 line 65–col. 8 line 6 describe that in the embodiments of FIGS. 1–3, “the bail ... cooperates with the pivotal finger units ... to provide almost continuous control over the sheet *with little or no ‘flotation’ of the sheet*, bounce back from the registration wall, or other undesirable sheet handling, due to the release of the sheet ... and engagement of the sheet by the bail tops... both occurring very closely above the top of the stack ... at all times” (emphasis added).

Holtje describes features that prevent the sheet from falling onto the stack, so that the sheet does not need to be positioned, whereas the features of claims 1 and 9 permit the sheet to fall and then position it with drag elements.

Referring to Michler, para. 33 and FIG. 1 describe that sheets “abut the set of barriers ... and are stacked upon the first set of separator fingers”. Michler has no discussion of the lateral position of sheets on the stack, but merely permits them to fall as they will on the stack.

Consequently, nothing in Holtje or Miller teaches any way of adjusting the lateral position of a sheet on the stack, much less the specific way of doing so using the drag elements of claims 1 and 9. Moreover, nothing in Holtje or Miller would give one skilled in the art a reasonable expectation of success at adjusting the lateral position after stacking, especially in light of Holtje’s express teaching that the lateral position of a sheet should be closely controlled at all times rather than compensated after the fact. Applicant therefore believes that claims 1 and 9 are novel and unobvious over Holtje and Miller, taken singly or in combination. Claims 2–8 depend from claim 1 and should be allowed with it. Applicant also believes that claim 1 is novel and unobvious over the cited references because of the accommodation segments, as discussed above.

Response to Arguments

Section 5 of the Office Action states that “Applicant has not claimed any structure to define the independent rotating in claim 1 such as two shafts.” Applicant believes the claim-1 language referred to is “at least two accommodation segments arranged on independently coaxially rotating stacking members.” As discussed in the remarks filed June 11, 2010, the claimed subject matter includes a plurality of rotating stacking members, each of which can rotate independently and all of which are aligned to the same axis (are coaxial).

Applicant fails to see how this is a functional feature in the sense of MPEP 2114. The courts have stated that “apparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (emphasis in original; cited in MPEP 2114). The same decision also gives the example that “[i]n the present case, the language ‘random

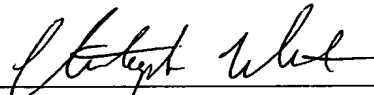
pattern, size, and height of rough spots' is certainly *different* than the surface of a knurled wheel" (id., emphasis in original). Two wheels welded to an axle are certainly structurally different from two wheels attached to the same axle by bearings. Two rotating stacking members capable only of rotating together (as disks 52 on shaft 54 shown in Holtje FIG. 3) are, by the same token, structurally different from two rotating members capable of rotating independently.

However a device is operated or functions, and regardless of the specific configuration chosen to implement independent rotation (whether bearings, slip fits, separate shafts, or any other structure), independently-rotating stacking members are certainly structurally different than non-independently-rotating stacking members. If there were no structural difference between independent and non-independent rotation, the word "independent" would be entirely devoid of meaning. However, "[a] fundamental rule of construction is that a court must give effect to every word or term employed by the parties and reject none as meaningless or surplusage in arriving at the intention of the contracting parties." *United States v. Hathaway*, 242 F.2d 897, 900 (9th Cir. Or. 1957). Here, the parties are Applicant and the United States, and the contract is one granting rights related to the claimed subject matter. The language "independently coaxially rotating" therefore must be given effect.

Applicant therefore respectfully submits that the relevant language in claim 1 is structural, not functional, that MPEP 2114 does not apply, and that the relevant language should be considered when evaluating patentability of the claim as a whole. Applicant believes this independent rotation provides significant advantages over Holtje and Michler, as discussed above, and that claim 1 is novel and unobvious over those references in view of this feature, as well as other features described above.

In view of the foregoing remarks and amendment, the claims are now deemed allowable and such favorable action is courteously solicited. Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned agent for the purpose of discussing such amendments.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Agent at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.